

Serial No. 10/0761,936
Response to Office Action of April 7, 2005

Filed: February 7, 2002

REMARKS

Claims 1, 6 and 11 have been amended. Claims 3, 5 and 9 have been cancelled without prejudice. Additionally, new claims 14 – 18 have been added. Favorable reconsideration and allowance of the present application are respectfully requested.

I. Rejections Under 35 U.S.C. § 102(e)

The Office Action rejected claims 1-13 under 35 U.S.C. § 102(e) as being anticipated by Ollikainen (U.S. Publication No. 2003/0074475). In view of the amendments to the claims, these rejections are respectfully traversed.

Claims 1 and 4

Independent claim 1 has been amended to clarify the viewable segment aspect of Applicants' invention. Support for the amendments to claim 1 can be found in the Application at least at page 10, lines 25-29 and page 11, lines 1-16. The proxy server is configured to divide the mark-up language file into a plurality of viewable segments including a first viewable segment and a second viewable segment that are each sized less than a display buffer of the wireless communication device. However, the proxy server initially transmits the first viewable segment and a navigation aid to the wireless communication device. Upon receipt of a selection of the navigation aid by the wireless communication device, the proxy server then transmits the second viewable segment to the wireless communication device.

While Ollikainen discloses the use of a buffer in conjunction with conversion of a requested file to a format suitable for a node, this is quite different than the viewable segments recited in amended claim 1. The buffer in Ollikainen's system is provided to prevent interruptions in the presentation of a file to the user:

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If presentation of the converted data requires more bits per second or more bandwidth than either link A, through which the required data is supplied to node A, can offer or conversion block 62 can produce, enough converted data must be stored in the buffer, i.e., on hard disk 61, before starting the presentation so that presentation at the user's end can be carried out from the beginning to the end without interruptions.

Ollikainen at paragraph 55 (emphasis added).

The presentation of a file from beginning to end without interruption, as described by Ollikainen, is significantly different than the viewable segments of Applicants' claimed invention. For example, claim 1 recites that "said proxy server transmits said second viewable segment upon receipt of a selection of said navigation aid by said wireless communication device." This feature means that the second viewable segment will not be transmitted by the proxy server until receipt of a selection of the navigation aid. By transmitting the markup file in viewable segments, the wireless communication device may display detailed information contained in the markup file, even though the wireless communication device may have limited data display capabilities. See page 3, lines 1-5 of the Application.

A rejection of claims 1 and 4 as obvious of Ollikainen would also be improper. It is well-established that a conclusion of obviousness turns on whether the prior art suggests the desirability of the modification. MPEP § 2145 indicates that it "is improper to combine references where the references teach away from their combination." Similarly, it is improper to modify a reference in an attempt to reject a claim where the reference teaches away from the modification. Here, Ollikainen actually teaches away from claim 1 by presenting a file "from the beginning to the end without interruptions," as opposed to transmitting "said second viewable segment upon receipt of a selection of said navigation aid by said wireless communication device." The continuous presentation of a file described by Ollikainen is truly the opposite of

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waiting to transmit a viewable segment until "receipt of a selection of said navigation aid." Therefore, none of the prior art taken alone or in combination teaches or suggests the limitation of claim 1. For the reasons stated above, independent claim 1, and the claims dependent therefrom, are patentable over the prior art. Applicants respectfully urge that an indication of allowability for claims 1 and 4 be provided.

If for some reason (not within contemplation at this time) another Official Action is required, it is respectfully requested that it be provided in non-final form since the subject matter relied on for patentability was previously examined in claims 2-3 (now cancelled and incorporated into amended claim 1). It is respectfully noted that any new or different rationale for the rejection of this subject matter would be considered a new ground of rejection, which would necessitate a non-final opportunity to respond. For example, it is urged that any of: (i) changing prior art relied on, (ii) changing from a 102-based to a 103-based rejection, or (iii) changing sections referred to in the prior art, or (iv) changing the rationale for the motivation for a modification/combination would necessitate a non-final opportunity to respond. See also MPEP § 706.07(a): "a second or subsequent action on the merits ... should not be made final if it includes a rejection ... of any claim amended to include limitation which should reasonably have been expected to be claimed."

Claims 6-8 and 10

Independent claim 6 has been amended to clarify the viewable segment feature of Applicants' invention. A mark-up language file is divided into a plurality of viewable segments, including a first viewable segment and a second viewable segment, that are sized to fit within a display buffer of a wireless communication device. The first viewable segment and a navigational aid are transmitted to the wireless communication device. The second viewable

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segment is transmitted in response to selection of the navigation aid by the wireless communication device.

As discussed above, Ollikainen teaches a continuous presentation of a file from beginning to end without interruption. Ollikainen does not teach or suggest the viewable segments recited in independent claim 6. Accordingly, independent claim 6 and those dependent therefrom are not anticipated by Ollikainen, and the rejections should be withdrawn.

Claims 11-13

Independent claim 11 has been amended to clarify the viewable segment feature of Applicants' invention. As amended, the system recited in claim 11 includes means for transmitting a first viewable segment and a navigation aid to the wireless communication device. Additionally, the system includes means for transmitting a second viewable segment to the wireless communication device upon selection of the navigation aid by the wireless communication device.

As discussed above, Ollikainen teaches a continuous presentation of a file from beginning to end without interruption. Ollikainen does not teach or suggest the viewable segments recited in independent claim 11. Accordingly, independent claim 11 and those dependent therefrom are not anticipated by Ollikainen, and the rejections should be withdrawn.

II. Conclusion

With this amendment and response, Applicants believe that the present pending claims of this application are allowable and respectfully requests the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be

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beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



Michael E. Wever
Attorney Reg. No. 43,984
Attorney for Applicant

MEW/bal/dlh

BRINKS HOFER GILSON & LIONE
CUSTOMER NO. 33391
Telephone: 317-636-0886
Facsimile: 317-634-6701